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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|--------------------------------|------------------|
| 10/529,426 | 03/25/2005 | David A. Bernard | OKC00480.US | 4528 |
| 33900 | 7590 | 03/07/2006 | | |
| FELLERS, SNIDER, BLANKENSHIP, BAILEY & TIPPENS, PC 100 NORTH BROADWAY SUITE 1700 OKLAHOMA CITY, OK 73102-8820 | | | | |
| | | | EXAMINER RACHUBA, MAURINA T | |
| | | | ART UNIT 3723 | PAPER NUMBER |

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/529,426

Applicant(s)

BERNARD ET AL.

Examiner

M Rachuba

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8 and 11-18 is/are rejected.
- 7) ☒ Claim(s) 3,4,9 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 5-8 and 11-12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bernard, 5735732, as set forth in the Office action mailed 14 October 2005.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernard, 5735732 in view of Whipple, 2426478, as set forth in the Office action mailed 14 October 2005.

Allowable Subject Matter

6. Claims 3, 4, 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed 17 January 2006 have been fully considered but they are not persuasive. Applicant argues that Bernard does not disclose a guide feature that maintains a longitudinal length of the bit along a predetermined axial line and at a predetermined angular orientation as the material is removed by the grinding wheel assembly. The examiner strongly disagrees. Bernard, column 7, lines 43 through column 8, lines 12, discloses the apparatus for point splitting, including a guide feature (projections to engage the flats of the chuck) that with the chuck properly orient the drill bit by maintaining a longitudinal length of the bit and a predetermined angular orientation of the bit relative to the grinding wheel assembly as the drill bit undergoes point splitting. The angular orientation can be interpreted as relative to the longitudinal axis, and cannot be reasonably limited to a *rotational* orientation of the bit relative to the grinding wheel assembly. It is the examiner's position that Bernard discloses the invention as broadly claimed by applicant, in claims 1, 2, 5-8 and 11-12. Further, Bernard, column 8, lines 1-12, discusses how the drill bit is maintained at a first

orientation, then a second orientation 180 degrees opposite the first orientation while removing a second portion of the material. Applicant does not claim any specific guide structure in the rejected claims, or any particular structure that prevents the bit from being removed, then reoriented relative to the grinding wheel assembly. Bernard clearly teaches maintaining the bit in the second orientation during material removal. It is the examiner's position that Bernard discloses the invention as broadly claimed by applicant, in claims 1, 2, 5-8 and 11-12.

8. Regarding applicant's argument against the combination of Bernard and Whipple to teach the recited structure of claims 13-18, applicant argues that Whipple does not teach attaching the vacuum tube structure to a port that can be alternatively used to sharpen the tool. Pending claim 13 recites "a debris collector to collect debris from the grinding wheel assembly, wherein the collector is adapted to be removeably coupled to either one of said ports while the chuck is inserted into the remaining one of said ports, and wherein the debris collector is further adapted to be connected to a vacuum hose." Whipple teaches a debris collector that is adapted to be removeably coupled to either one of the ports, as the collector is removeably connected to the housing, and therefore to both ports, when either of the ports is in use. Applicant has not claimed any particular structure to directly connect the collector to a sharpening port. Applicant is reminded that the features upon which applicant relies (i.e., the structure that connects the collector to a sharpening port) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed.

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Cir. 1993). The examiner is prohibited from reading limitations from the specification into the claims.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

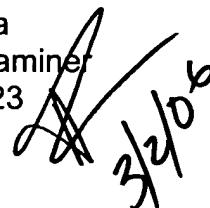
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M Rachuba whose telephone number is 571-272-4493. The examiner can normally be reached on Monday-Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571-272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M Rachuba
Primary Examiner
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Handwritten signature and date 3/2/06.